

ESTTA Tracking number: **ESTTA732760**

Filing date: **03/10/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	3M Company		
Entity	Corporation	Citizenship	Delaware
Address	3M Center, 2501 Hudson Road St. Paul, MN 55144 UNITED STATES		

Attorney information	Scott W. Johnston Merchant & Gould P.C. P.O. Box 2910 Minneapolis, MN 55402-0910 UNITED STATES sjohnston@merchantgould.com, slindemeier@merchantgould.com, dmattessich@merchantgould.com, aavery@merchantgould.com, dockm-pls@merchantgould.com Phone:612-332-5300
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### Applicant Information

Application No	86761099	Publication date	02/09/2016
Opposition Filing Date	03/10/2016	Opposition Period Ends	03/10/2016
Applicant	MediSpor Hulsenweg 5A Nederweert, 6031SP NETHERLANDS		

### Goods/Services Affected by Opposition

Class 005. First Use: 0 First Use In Commerce: 0  
All goods and services in the class are opposed, namely: Adhesive tapes for medical purposes; First aid kits; Medical adhesive tape

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1489843	Application Date	10/19/1987
Registration Date	05/31/1988	Foreign Priority Date	NONE
Word Mark	MEDIPORE		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 005. First use: First Use: 1987/09/29 First Use In Commerce: 1987/09/29 BANDAGING TAPE FOR SKIN WOUNDS

Attachments	2016 03 10 Notice of Opposition 86761099 MEDISPOR.PDF(329135 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/SWJ/
Name	Scott W. Johnston
Date	03/10/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

3M Company,	)	Opposition No. _____
	)	
Opposer,	)	
	)	Mark: <b>MEDISPOR</b>
v.	)	
	)	Serial No.: 86/761099
MediSpor/Anthony Verberkt,	)	
	)	Filing Date: September 18, 2015
Applicant.	)	
_____	)	Published: February 9, 2016

**NOTICE OF OPPOSITION**

3M Company (hereinafter “Opposer”), a Delaware corporation located at 3M Center, 2501 Hudson Road, St. Paul, Minnesota 55144, believes that it will be damaged by the registration of the mark MEDISPOR shown in trademark application Serial No. 86/761099, filed on September 18, 2015, by MediSpor/Anthony Verberkt (hereinafter “Applicant”), and hereby opposes the same. The grounds for opposition are as follows:

1. By the application herein opposed, Applicant is seeking to obtain under the provisions of the Trademark Act of 1946 as amended, registration on the Principal Register of the trademark MEDISPOR for “adhesive tapes for medical purposes; first aid kits; medical adhesive tape,” in International Class 5.
2. Applicant’s mark published for opposition on February 9, 2016 based on Applicant’s intent-to-use the MEDISPOR mark in U.S. commerce. This Notice of Opposition is timely filed.
3. Since at least as early as 1987, Opposer has been using the trademark MEDIPORE to identify and promote its bandaging tape for skin wounds. Opposer also uses the MEDIPORE trademark as a source indicator for medical cloth tape and medical dressing covers. Opposer’s

MEDIPORE products have been heavily promoted and immensely successful. MEDIPORE products are sold all over the world and throughout the United States.

4. Opposer owns the following registration for its MEDIPORE mark:

Mark	Reg. No. / Reg. Date  Serial No. / Filing Date	Use Date	Goods
MEDIPORE	1489843 May 31, 1988  73690289 October 19, 1987	Sept. 29, 1987	Bandaging tape for skin wounds, in International Class 5.

Current printouts of information from the electronic database records of the USPTO showing the current status and title of the registration are attached hereto as Exhibit A.

5. The registration listed in the above table has not been canceled, is valid, and is now in full force and effect.

6. Registration No. 1489843 is incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065. Consequently, this registration is conclusive evidence of the validity of the registered mark and of the registration of the mark, of Opposer's ownership of the mark, and of Opposer's exclusive right to use the registered mark in commerce under Section 33 of the Lanham Act, 15 U.S.C. § 1115.

7. Opposer has advertised and promoted its MEDIPORE mark continuously and extensively, and made substantial sales of goods under said mark. As a result of such continuous use and promotion, the MEDIPORE mark has developed and represents valuable goodwill inuring to the benefit of Opposer.

8. Opposer adopted and commenced use of the designation MEDIPORE as a trademark long before Applicant adopted the MEDISPOR mark.

9. There is no issue of priority concerning Applicant's MEDISPOR mark since Opposer used and registered the MEDIPORE mark prior to Applicant's September 18, 2015 filing date. Opposer's usage of the MEDIPORE mark commenced at least as early as September 29, 1987, approximately twenty-eight (28) years prior to the filing date of Applicant's application. Opposer therefore has priority over Applicant with respect to the mark at issue.

10. Upon information and belief, Applicant had knowledge of the fact that Opposer used the term MEDIPORE as a trademark before it adopted the MEDISPOR mark.

11. Applicant's MEDISPOR mark is confusingly and deceptively similar to Opposer's previously used MEDIPORE mark. The marks are nearly identical in sight, sound and meaning. For example, both marks start with "MEDI," include the term with "POR" and connote something medical-related.

12. Applicant's alleged goods are closely related to Opposer's goods that are marketed and sold by Opposer in connection with its MEDIPORE mark. For example, both parties' goods are for medical tape and related first-aid products.

13. Upon information and belief, the parties' goods are or will be promoted and sold to the same customers, through the same channels of trade.

14. Due to the similarity between the parties' marks, the closely related nature of the goods of the respective parties, customers and potential customers are likely to believe that Applicant's goods originate from Opposer, resulting in a likelihood of confusion in the marketplace, and damage to Opposer.

15. The use and registration by Applicant of the mark MEDISPOR for Applicant's goods is likely to cause confusion or to cause mistake or deception in the trade, and among purchasers and potential purchasers, with Opposer's previously used MEDIPORE mark, again resulting in damage to Opposer.

16. Because of the nearly identical nature of the parties' marks and goods, use and registration of the term MEDISPOR by Applicant is likely to cause confusion, mistake, or deception that Applicant's goods are those of Opposer, or are otherwise endorsed, sponsored, or approved by Opposer causing further damage to Opposer.

18. Registration of the mark shown in Application Serial No. 86/761099 will result in damage to Opposer under the provisions of Section 2 of the U.S. Trademark Act, 15 U.S.C. Section 1052, pursuant to the allegations stated above.

WHEREFORE, Opposer asks that its opposition to this application be sustained and that registration of the term MEDISPOR for the goods set forth therein be refused.

Please direct all correspondence to:

Scott W. Johnston  
MERCHANT & GOULD P.C.  
P.O. Box 2910  
Minneapolis, MN 55402-0910

Opposer herein appoints John A. Clifford, Reg. No. 30,247; Gregory C. Golla; Andrew S. Ehard; Scott W. Johnston, Reg. No. 39,721; Dana Jozefczyk; Heather J. Kliebenstein; Danielle I. Mattessich; Christopher J. Schulte; William D. Schultz, and all other attorneys of the firm of Merchant & Gould P.C., its attorneys to transact all business in the U.S. Patent and Trademark Office relating to this matter with full power of substitution.

Respectfully submitted,

3M COMPANY  
By its Attorneys,



Scott W. Johnston  
Danielle I. Mattessich  
MERCHANT & GOULD P.C.  
80 South Eighth Street, Suite 3200  
Minneapolis, Minnesota 55402-2215  
(612) 332-5300

Date: 3-10-16

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION  
was served upon Applicant by UPS overnight courier this 10th day of March, 2016:

MediSpor  
Anthony Verberkt  
Hulsenweg 5A  
Nederweert NETHERLANDS 6031SP  
info@medispor.com (courtesy copy)

  
\_\_\_\_\_  
Scott W. Johnston

**EXHIBIT A**



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Mark: MEDIPORE

US Serial Number: 73690289

Application Filing Date: Oct. 19, 1987

US Registration Number: 1489843

Registration Date: May 31, 1988

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Jul. 10, 2008

Publication Date: Mar. 08, 1988

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## Mark Information

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Mark Literal Elements: MEDIPORE

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

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## Goods and Services

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Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*,\* identify additional (new) wording in the goods/services.

For: BANDAGING TAPE FOR SKIN WOUNDS

International Class(es): 005 - Primary Class

U.S Class(es): 044

Class Status: ACTIVE

Basis: 1(a)

First Use: Sep. 29, 1987

Use in Commerce: Sep. 29, 1987

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## Basis Information (Case Level)

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Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

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## Current Owner(s) Information

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Owner Name: 3M Company

Owner Address: 220-9E-01  
3M Center, 2501 Hudson Road  
St. Paul, MINNESOTA 55144  
UNITED STATES

Legal Entity Type: CORPORATION

State or Country DELAWARE  
Where Organized:

## Attorney/Correspondence Information

**Attorney Name:** James F. Voegeli  
**Attorney Primary Email Address:** [trademarks@mmm.com](mailto:trademarks@mmm.com)  
**Correspondent Name/Address:** James F. Voegeli  
3M Innovative Properties Company  
3M Center, 2501 Hudson Road  
220-9E-01  
St. Paul, MINNESOTA 55144  
UNITED STATES  
**Phone:** 651 736-6989  
**Correspondent e-mail:** [trademarks@mmm.com](mailto:trademarks@mmm.com)

**Attorney of Record**  
**Docket Number:** 05159  
**Attorney Email Authorized:** Yes  
**Correspondent**  
**Fax:** 651 736-3783  
**Correspondent e-mail Authorized:** Yes

Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Jul. 10, 2008	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	75184
Jul. 10, 2008	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Jun. 26, 2008	CASE FILE IN TIGRS	
Jun. 11, 2008	ASSIGNED TO PARALEGAL	75184
May 29, 2008	TEAS SECTION 8 & 9 RECEIVED	
Sep. 29, 1993	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Jun. 16, 1993	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
May 31, 1988	REGISTERED-PRINCIPAL REGISTER	
Mar. 08, 1988	PUBLISHED FOR OPPOSITION	
Feb. 12, 1988	NOTICE OF PUBLICATION	
Feb. 06, 1988	NOTICE OF PUBLICATION	
Jan. 13, 1988	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 07, 1988	ASSIGNED TO EXAMINER	60740

## Maintenance Filings or Post Registration Information

**Affidavit of Continued Use:** Section 8 - Accepted

**Affidavit of Incontestability:** Section 15 - Accepted

**Renewal Date:** May 31, 2008

## TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: POST REGISTRATION

Date in Location: Jul. 10, 2008

## Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Registrant: MINNESOTA MINING AND MANUFACTURING

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**Assignment 1 of 1**

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**Conveyance:** MERGER AND CHANGE OF NAME**Reel/Frame:** 2502/0547**Pages:** 40**Date Recorded:** Apr. 30, 2002**Supporting Documents:** assignment-tm-2502-0547.pdf**Name:** MINNESOTA MINING AND MANUFACTURING COMPANY**Assignor****Execution Date:** Apr. 08, 2002**Legal Entity Type:** CORPORATION**State or Country** DELAWARE  
**Where Organized:****Assignee****Name:** 3M COMPANY**Legal Entity Type:** CORPORATION**State or Country** DELAWARE  
**Where Organized:****Address:** 3M CENTER  
2501 HUDSON ROAD  
ST. PAUL, MINNESOTA 55144**Correspondent****Correspondent Name:** JAMES F. VOEGELI**Correspondent Address:** 3M CENTER, BLDG. 220-11W-01  
P.O. BOX 33427  
ST. PAUL, MINNESOTA 55133-3427**Domestic Representative - Not Found**